

REMARKS

In response to the Office Action dated August 27, 2003, claims 17-23 are added. Claims 1-9 and 17-23 are now active in this application. No new matter has been added.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yano et al. (USPN 6,031,9410 in view of Lanne et al. (USPN 4,663,658). The Examiner admits that Yano et al. does not disclose displaying the image to perform framing so that the guide image is overlapped on the image of the object before shooting the object. The Examiner maintains that Lanne et al. teaches that it is know to perform framing so that the guide image is overlapped on the object image and asserts that it would have been obvious to one of ordinary skill in the art to modify the framing disclosed by Katayama to include overlapping the guide image on the object to assist in positioning.

The rejections are respectfully traversed.

Independent claim 1 recites, *inter alia*:

generating image data of a *three-dimensional shape model in accordance with the three-dimensional data* inputted from a part of the object, the image corresponding to the shape of the three-dimensional data;

displaying the image of *the three-dimensional shape model* on the monitor screen *as a guide image for framing*;

performing a framing so that the guide image is overlapped on an image of the object image that corresponds to the guide image...

Independent claim 2 recites, *inter alia*:

an image generator for *generating a three-dimensional model image of the object in accordance with the three-dimensional data of the object obtained by the shooting*; and
 a display controller for *displaying the three-dimensional model image as a guide image on the monitor for framing*.

Independent claim 5 recites, *inter alia*:

displaying an image of a three-dimensional shape model
 having a shape substantially identical to the object *as a guide image for framing on the monitor screen*, the image of the three-dimensional shape model being based on a predetermined three-dimensional shape model data;
framing in accordance with the guide image...

In Yano et al., a user determines *framing* while observing the displayed image sensed by camera 2, *so that the object to be measured is located at nearly the center of the window* 32, and thereafter, he or she presses a shutter. There is nothing in this description, or in any other part of the disclosure of Yano et al., that discloses or suggests displaying an image of a three-dimensional shape model as a guide image and then performing framing in accordance with this guide image (see claims 1, 2 and 5), or that framing is performed so that the guide image is overlapped on an image of the object image that corresponds to the guide image (see claim 1).

Use of a three-dimensional shape model as a guide image used in framing, or when performing framing, overlapping of the guide image corresponding to the three-dimensional shape model of the three-dimensional data inputted from a part of the object with an image of the object image that corresponds to the guide image, is neither contemplated nor necessary for the arrangement of Yano et al. to generate the three-dimensional model of the object to be measured. The framing that is

contemplated in Yano et al. is clearly merely *to locate the object to be measured in the center of the finder window 32* (see FIG. 3). This framing has nothing to do with using a guide image, which is an image of a three-dimensional shape model having a shape substantially identical to the object displayed/to be shot.

Lanne et al. discloses a process and a device for assisting the manual positioning of workpieces *to be machined and/or assembled*, in order *to simplify machining and assembly*, by eliminating the corresponding tools or the prior tracing or workpieces to be positioned. Such purpose, *to simplify machining and assembly*, has no relationship to the forming of the three-dimensional model disclosed in Yano et al.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by *Graham v. John Deere Co.*, 86 S.Ct. 684, 383 U.S. 117, 148 USPQ 459, 469 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or to combine applied references to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

In establishing the requisite motivation, it has been consistently held that both the suggestion and the reasonable expectation of success must stem from the prior art itself, as a whole. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Applicants stress that the requisite motivation to support the obviousness conclusion is not an abstract concept, but must stem from the prior art as a whole to impel one having ordinary skill in the art to modify a reference or combine references with a reasonable expectation of successfully achieving some particular realistic objective. See, for example, *In re Gyurik*, 596 F.2d 1012, 201 USPQ 552 (CCPA 1979). Consistent legal precedent admonishes against the indiscriminate combination of prior art references. *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979).

It is Applicants' position that the Examiner has not articulated any logical reason why one having ordinary skill in the art would have been motivated to modify and/or combine the applied references to arrive at the claimed invention. More specifically, it is not apparent whence stems the requisite motivation for one having ordinary skill in the art to zero in on the methodology of Lanne et al. for assisting the manual positioning of workpieces *to be machined and/or assembled*, in order *to simplify machining and assembly*, then insert this methodology in the arrangement

of Yanno et al., which is concerned with generating the three-dimensional model of an object to be measured by sequentially adding the data of the three-dimensional model to a three-dimensional mode storage unit, and has no disclosure concerning manual positioning of workpieces *to be machined and/or assembled*.

Recognizing, after the fact, that a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 379 F.2d 1011, 154, USPQ 173 (CCPA 1967).

It is impermissible simply to engage in hindsight reconstruction of the claimed invention, using applicants' structure as a template and selecting elements from references to fill in the gaps. *In re Gorman*, 18 USPQ2d 1885 (Fed. Cir. 1991).

Frankly, the only apparent motivation of record for the proposed modification of the arrangement of Yanno et al. with the methodology disclosed by Lanne et al. to arrive at the claimed inventions is found in Applicants' disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987). It is, therefore, respectfully submitted that the Examiner has not established the requisite motivation for the proposed combination of references to arrive at the claimed invention.

Finally, the present claims delineate that the guide image is an image of a three-dimensional shape model. In contrast, the image P' displayed in screen 1, provided by camera 2, is not an image of a three-dimensional shape model based upon three-dimensional shape model data. Image P' is merely a two-dimensional (TV) image taken of workpiece P and a person of ordinary skill in the art would understand that image P' is NOT an image of a three-dimensional shape model based upon three-dimensional shape model data. Thus, even if the methodology of Lanne et al. were somehow combined with the arrangement of Yano et al., the claimed invention would not result as the finder window 32 would shown a *two-dimensional image (P') of object (P)* input by scanning camera 2 overlapping *a stored image (p') of a model (p) of the object (P)* (see column 2, lines 35-45 of Lanne et al.), not *an image of a three-dimensional shape model* based upon three-dimensional shape model data overlapping on *an image of the object*. The required image of the object is not an image of a model of the object.

In view of the above, withdrawal of the Examiner's rejection of claims 1-9 under 35 U.S.C. § 103 is respectfully solicited.

NEW CLAIMS

In the Amendment dated June 18, 2003, claims 10-16 were canceled. However, the canceling of claims 10-16 was an error. As noted in the previous response, what is framed in Katayama is merely the image of the object displayed in the finder window. It is only after framing occurs that the image of the object is scanned to obtain image data of the object (see page 20, second sentence of

paragraph 0391). This was different from independent claims 10 and 13 in that the displayed guide image used from framing/scaling was based upon a prior shooting of the object. Thus, independent claims 10 and 12 were patentable over Katayama et al. (US 2002/0081919) for the same reasons why independent claims 1, 2 and 5 were patentable over this reference, and claims 10-16 should not have been canceled.

Consequently, claims 10-16 are resubmitted in this response as new claims 17-23. It should be noted that claim 18, corresponding to original claim 11, has the word "with" added after "agrees" for better form.

Independent claims 17 and 20 are patentable over Yano et al. (USPN 6,031,9410 and Lanne et al. (USPN 4,663,658) for reasons similar to the reasons as to why independent claims 1, 2 and 5 are patentable over these references. Therefore, the allowance of new independent claims 17 and 20, as well as of dependent claims 18, 19 and 21-23, is respectfully solicited.

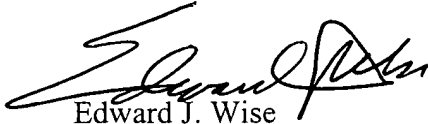
CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Edward J. Wise
Registration No. 34,523

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 EJW:dmd
Facsimile: (202) 756-8087
Date: December 19, 2003